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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,732	09/29/2003	Takeshi Kinsho	0171-1022P	6775
2292	7590	07/07/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			LEE, SIN J	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 07/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/671,732

Applicant(s)

KINSHO ET AL.

Examiner

Sin J. Lee

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,11,14,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 3,12,13 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. In view of the amendment of April 20, 2005, previous rejection on claim 3 under 35 U.S.C. 112, second paragraph is hereby withdrawn.

#### ***Claim Objections***

2. Claim 12 is objected to because of the following informalities: On the fourteenth line following the chemical formulas (L1)-(L3), applicants need to change "with proviso that R<sup>L04</sup>, R<sup>L05</sup> and R<sup>L06</sup> are not methyl groups a the same time" to --- with proviso that R<sup>L01</sup>, R<sup>L02</sup> and R<sup>L03</sup> are not methyl groups at the same time ---. Appropriate correction is required.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 4, 11, 14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al (JP 56-110693 and its English translation provided by PTO).

Sakurai discloses (2-triethylsiloxycarbonylallyl)trimethylsilane which structure is  $(\text{CH}_3)_3\text{SiCH}_2\text{-C(=CH}_2\text{)-COOSi(CH}_2\text{CH}_3)_3$  (see pg.2, eighth paragraph of English translation). This compound teaches present compound of formulas (1), (2), and (4) (the triethylsilyl group  $(\text{-Si(CH}_2\text{CH}_3)_3)$  is an acid-labile group and a monovalent organic group of 6 carbon atoms containing one silicon atom). Therefore, Sakurai teaches present inventions of claims 1, 2, 4, 14, 16, and 17.

With respect to present claim 11, Sakurai also discloses (2-methoxycarbonylallyl)trimethylsilane which structure is  $(\text{CH}_3)_3\text{SiCH}_2\text{-C(=CH}_2\text{)-COOCH}_3$  (see pg.2, eighth paragraph of English translation). This compound teaches present compound of formula (1) wherein  $\text{R}^1$  is a  $\text{-CH}_3$  group which is a primary hydrocarbon group of 1 carbon atom. Therefore, the prior art teaches present inventions of claims 1 and 11.

#### ***Allowable Subject Matter***

6. Claims 3, 12, 13, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Sakurai et al (JP'693) does not teach or suggest present compound of formula (3) of claim 3, in which  $\text{R}^3$  is a monovalent organic group which has to contain an oxygen functional group. Sakurai et

al (JP'693) does not teach or suggest present acid labile group of claim 12 having formula (L1), (L2), or (L3).

7. Claims 5-10 are allowed. Sakurai et al (JP'693) does not teach or suggest present synthesis method of claim 5. Haider ("A Simple Synthesis of (2-Ethoxycarbonylallyl)trimethylsilane, A Potential Synthon for the Synthesis of 2-Methylene-4-alkanolides", Synthesis (1985), (3), pg.271-2) does not teach or suggest present synthesis method of claim 5, which requires the use of an oxalate (Haider uses ethoxalyl chloride instead). Sakurai et al (JP'693) does not teach or suggest present polymer of claim 6. Rizzardo et al'511 teaches (see Example 33) a polymer which is a poly(methyl methacrylate) prepared by using ethyl  $\alpha$ -(trimethylsilylmethyl)acrylate  $((CH_3)_3Si-CH_2-C(=CH_2)-COO-CH_2CH_3)$  as a chain transfer agent for methyl methacrylate. However, Rizzardo's polymer has molecular weight of 137,986 which is clearly out of the present range (2,000-100,000) of claim 6.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

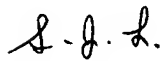
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published applications may be obtained from either Private PAIR or Public PAIR.

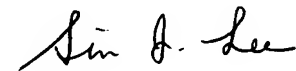
Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee  
July 6, 2005



**SIN LEE**  
**PRIMARY EXAMINER**